

Preliminary Amendment
Docket No. A0856REMARKS

Claims are 1-7, 10-17, 20-27, and 30-33 are pending. Claims 1-7, 11-17, 21-27, and 31-33 have been amended. Claims 34-41 are new. Claims 1-7, 10-17, 20-27, and 30-41 remain in the application.

- 5 This paper is being submitted with a Request for Continued Examination under 37 C.F.R. § 1.114.

The Information Disclosure Statement mailed on August 30, 2007 was not acknowledged in the present final Office action. This Information Disclosure Statement was timely filed and must be considered on the record. 37 C.F.R. § 10

10 1.97(c). Acknowledgement of the foregoing Information Disclosure Statement and entry of the cited art references are respectfully requested.

- 15 Claims 1, 2, 6, 7, 10-12, 16, 17, 20-22, 26, 27, and 30-33 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,794,207, issued to Walker et al. ("Walker") in view of U.S. Patent No. 6,529,885, issued to Johnson. Applicant traverses the rejection.

20 The prior Office action responses of March 29, 2006; July 19, 2006; January 19, 2007; and July 5, 2007 are incorporated by reference. The outstanding final Office language fails to reflect the previously presented amendments regarding the obviousness rejection. Applicant requests a proper examination for considering the claim amendments and remarks. See 37 C.F.R. 1.104(a)(1).

- 25 The Walker patent discloses a method and apparatus for facilitating buyer-driven conditional purchase offers (CPOs). A buyer who wishes to make a purchase accesses a central controller located at a remote server and creates a CPO by specifying the subject of the goods and any other conditions that the buyer requires (Col. 8, lines 44-49). The buyer logs on to the central controller, creates the CPO, and disconnects from the network (Col. 15, lines 49-50). When formulating the CPO, the buyer adds the conditions that are the terms of the CPO that allow the buyer to tailor the CPO for his specific needs (Col. 16, lines 19-45). Standard legal provisions and language are integrated with the CPO to "fill in the gaps" of the buyer's purchase offer (Col. 8, lines 61-63). The CPO is made available to potential sellers by posting the CPO on a Web page of the central

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controller (Col. 15, lines 50-52). Seller responses are transmitted electronically to the central controller, which contacts the buyer to indicate that the CPO has been bound (Col. 15, lines 56-58). The central controller transfers credit card information to the seller as soon as the CPO is bound (Col. 15, lines 58-59).

- 5 Various methods of payment may be utilized, including credit cards, and the timing of payment can be varied, including paying the seller immediately after the seller accepts the CPO or delayed until after the seller performs his obligations under the contract (Col. 9, lines 33-43).

The Johnson patent discloses methods and systems for securely carrying out electronic transactions, including electronic drafts, where payment on at least one draft is contingent upon the removal of an associated contingency (Abs.). The option to remove each contingency associated with a draft can only be exercised by an authenticated party or authenticated contingency remover (Abs.; Col. 23, lines 5-15). A secure computer site that is controlled by a bank and that is accessible only to authenticated parties to a transaction is established (Col. 4, lines 54-57). The site is configured to provide a description of a contingency and to include an option to remove the contingency, which is a precondition to the bank releasing payment on the draft to a payee of the draft (Col. 4, lines 57-61). A Web seller receives a purchase request from a Web buyer (Col. 12, lines 32-33). The Web buyer and the Web seller may then establish a secure communication channel to the secure computer site (Col. 12, lines 42-46). Bank iDraft software at the Web seller's site receives the Web buyer's identification and executes an iDraft transaction (Col. 12, lines 62-65). The Web buyer may be authenticated and the Web buyer's home bank may wish to check the now-authenticated Web buyer's current account balances or credit limits before authorizing or releasing payment on the iDraft transaction (Col. 13, lines 44-49). Payment on the draft is released to the payee only when a drawer of the draft is successfully authenticated by the bank and when the option to remove the contingency is timely exercised by an authenticated party that is authorized to remove the contingency (Col. 4, line 67- Col. 5, line 4). Once payment is released, the Web buyer's account is debited for the amount of the purchase and the Web seller's account is correspondingly

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credited for the amount of the purchase (Col. 13, lines 49-54).

To establish a *prima facie* case of obviousness, the examiner has the burden of proving that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there is a reasonable expectation of success; and (3) the combined references teach or suggest all the claim limitations. MPEP 2143. A *prima facie* of obviousness case has not been shown.¹

First, there is no suggestion or motivation to modify or combine the references. Walker teaches facilitating CPO transactions in which sellers receive binding purchase offers from buyers. The buyers' offers contain conditions and acceptance of the offers with the associated conditions by the sellers binds the parties to a contract. Johnson teaches facilitating electronic commerce transactions that include contingencies as preconditions to the release of payment.

The conditions taught by Walker and the contingencies taught by Johnson are distinct. A condition, as taught by Walker, originates with a buyer and must be met by a seller only after which a legally binding contract is formed. A contingency, as taught by Johnson, can originate with and can be removed by a buyer, seller, or third party, and can be applicable to parts of the transaction existing independently of the buyer's needs. Moreover, a contingency, as taught by Johnson, only applies to parties that are already legally bound by a contract and a third party, such as a bank. Thus, the post-contract formation contingency removal taught by Johnson teaches away from the pre-contract formation buyer condition specification taught by Walker and one of ordinary skill in the art would not be inclined to modify or combine these references.

¹ Applicant's representative acknowledges the publication of the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007) ("KSR Guidelines"), which were effective October 10, 2007. However, the present Office action was mailed prior to the effective date of the KSR Guidelines. The response follows the teaching-suggestion-motivation rationale in effect at the time of mailing, which is also retained by the new KSR Guidelines.

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Arguably, a reasonable expectation of success exists. Combining Johnson's teaching would add post-contract formation contingency checking into the pre-contract formation condition specification taught by Walker, even though the pre-contract condition specification does not require, and can operate wholly independently from, post-contract formation contingency clearance.

Nevertheless, the combined references fail to teach or suggest all the claim limitations. Amended Claim 1 defines an automated method for selling information to a buying system. Amended Claim 11 defines a system for selling information to a buying system. Amended Claim 21 defines a computer readable medium have stored instructions for selling information to a buying system. Additionally, Claim 1 now recites relating information to an event that has not yet occurred and storing the information in electronic form, offering the information for sale through a selling system, and receiving from a buying system an offer for the information that includes a contingency that specifies an uncertainty of the event occurring. Claim 11 now recites a relation module to relate information to an event that has not yet occurred, an offer module to offer the information for online sale, and a receiving module to receive an offer from the buying system for the information that includes a contingency that specifies an uncertainty of the event occurring. Claim 21 now recites a processor to perform relating information to an event that has not yet occurred and storing the information in electronic form, offering the information for sale through a selling system, and receiving from a buying system an offer for the information that includes a contingency that specifies an uncertainty of the event occurring. No new matter has been entered. Support for the amendments can be found in the specification, for example, on page 5, lines 8-25; page 8, line 13-page 9, line 4; and FIGURES 1-2. No contract is formed by mere acceptance of the buyer's offer.

In contrast, Walker teaches allowing a buyer to impose conditions on a CPO, wherein the only element missing that would make the CPO a binding contract is acceptance by the seller, specifically, the name and signature of the seller (Col. 17, lines 4-7). The seller must accept the buyer's conditions as a precondition to contract formation. The buyer's CPO is binding since the CPO

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sets out every term and condition by which the buyer will allow himself to be bound into a contract (Col. 4, lines 16-27). Amended Claims 1, 11, and 21 defer contract formation, which Walker teaches is a non-biding request for proposal (Col. 4, line 17).

5 Additionally, Claim 1 recites specifying a condition for the information that will resolve the uncertainty and thereby satisfy the contingency and providing the information and the condition from the selling system, wherin acceptance of the condition forms a contract. Claim 11 recites a specification module to specify a condition for the information that will resolve the uncertainty and thereby 10 satisfy the contingency and a condition module to provide the information and the condition, wherein acceptance of the condition forms a contract. Claim 21 recites a processor to perform specifying a condition for the information that will resolve the uncertainty and thereby satisfy the contingency and providing the information and the condition from the selling system, wherein acceptance of the condition 15 forms a contract. No new matter has been entered. Support for the amendments can be found in the specification, for example, on page 9, lines 5-22; page 11, line 22-page 12, line 3; and FIGURE 2. A contract is formed when the buyer accepts the seller's conditions about the contingency that was included with the information. In contrast, Walker teaches that a contract is formed when the seller 20 accepts the buyer's conditions. In amended Claims 1, 11, and 21, a seller may respond to a buyer's offer by including conditions about the buyer's contingency, but a contract is not formed until the buyer accepts the condition. Thus, a seller is not bound, and need not perform, if a buyer rejects the seller's conditions.

25 Additionally, Claim 1 recites triggering at least part of a payment from the buying system upon satisfaction of the condition and receiving the payment upon the buying system having determined that the satisfaction of the condition has resolved the uncertainty and thereby satisfied the contingency. Claim 11 recites a trigger module to trigger at least part of a payment from the buying system upon satisfaction of the condition and a contingent payment module to receive the 30 payment upon the buying system having determined that the satisfaction of the condition has resolved the uncertainty and thereby satisfied the contingency.

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Claim 21 recites a processor to perform triggering at least part of a payment from the buying system upon satisfaction of the condition and receiving the payment upon the buying system having determined that the satisfaction of the condition has resolved the uncertainty and thereby satisfied the contingency. No new matter 5 has been entered. Support for the amendments can be found in the specification, for example, on page 12, lines 8-15; and FIGURE 2. The buyer is able to confirm that the contingency, which will trigger at least part of the payment, has been resolved by the seller's condition that was included with the information. In contrast, Johnson teaches that the occurrence of an event related to the 10 information or goods alone will not serve to remove a contingency. A contingency in Johnson is a precondition for a bank to release payment or take other action following removal of the contingency under the contract by either party or bank (Col. 4, lines 50-61).

Finally, the Examiner, again, has not recognized or acknowledged our 15 request for an affidavit, nor has such affidavit been provided. Applicant traverses the Official notice taken to assert that "an artisan of ordinary skill in the art at the time of the invention would find a suggestion or motivation to substitute the CPO in Walker with Johnson's transaction features of iDRAFTTM and iDRAFT-CTM because an artisan at the time of the iTX, of Walker's invention would have 20 recognized the competitive nature of effectuating bilateral buyer-driven commerce and would have availed themselves of the latest technology infrastructure to address the complexities of multi buyer/seller transactions." Applicant further traverses Official notice taken to assert that "an artisan at the time of Walker would have been motivated to buy and sell information via the 25 receiving a first payment for the good or service if the at least one condition for the CPO is satisfied after the good or service has been provided to the buyer [sic]." Merely quoting the claims is insufficient motivation. Thus, **Applicant requests an affidavit from the Examiner in support of such taking of Official notice in respect to the limitations of Claims 1, 11, and 21. See 37 C.F.R. § 30 1.104(d)(2).**

Accordingly, a prima facie case of obviousness has not been shown for

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- independent Claims 1, 11, and 21. Claims 2, 6, 7, 10, and 31 are dependent on Claim 1 and are patentable for the reasons stated above with respect to the anticipation rejection, and as further distinguished by the limitations therein.
- Claims 11, 12, 16, 17, 20, and 32 are dependent on Claim 11 and are patentable
- 5 for the reasons stated above with respect to the anticipation rejection, and as further distinguished by the limitations therein. Claims 22, 26, 27, 33 are dependent on Claim 21 and are patentable for the reasons stated above with respect to the anticipation rejection, and as further distinguished by the limitations therein. Subsequently, a *prima facie* case of obviousness has not been shown.
- 10 Withdrawal of the rejection is requested.
- Claims 3-5, 13-15, and 23-25 stand rejected under 35 U.S.C. § 103(a) as being obvious over Walker as modified by Johnson as applied to Claim 1 and further in view of U.S. Patent No. 5,608,620, issued to Lundgren. Applicant traverses the rejection.
- 15 Claims 3-5 are dependent on Claim 1 and are patentable for the reasons stated above with respect to the anticipation rejection, and as further distinguished by the limitations therein. Claims 13-15 are dependent on Claim 11 and are patentable for the reasons stated above with respect to the anticipation rejection, and as further distinguished by the limitations therein. Claims 23-25 are
- 20 dependent on Claim 21 and are patentable for the reasons stated above with respect to the anticipation rejection, and as further distinguished by the limitations therein. Subsequently, a *prima facie* case of obviousness has not been shown.
- Withdrawal of the rejection is requested.
- Claims 34-41 are new. No new matter has been entered. Support can be
- 25 found in the specification, for example, on page 5, lines 8-25; page 8, line 13-page 9, line 4; page 9, lines 5-22; page 11, line 22-page 12, line 3; page 12, lines 8-15; and FIGURES 1-3. The new claims recite selecting a predicted probability for the specified condition and determining the amount of payment the seller receives from the buyer based on a function utilizing the predicted probability.
- 30 The prior art made of record and not relied upon has been reviewed by the applicant and is considered to be no more pertinent than the prior art references

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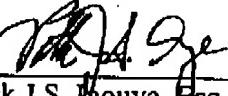
already applied.

Claims 1-7, 10-17, 20-27, and 30-41 are believed to be in condition for allowance. Entry of the foregoing amendments is respectfully requested.

Reconsideration of the claims, withdrawal of the finality of the Office action, and 5 a Notice of Allowance are earnestly solicited. Please contact the undersigned at (206) 381-3900 regarding any questions or concerns associated with the present matter.

Respectfully submitted,

10 Dated: October 31, 2007

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